SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
DEC 8 1961
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

No. 535—October Term 1961.

ROOSEVELT MOORE,
Petitioner,

vs.

JACK P. HENNESSY CO., INC.,
Respondent.

ROOSEVELT MOORE,
Petitioner,

vs.

ATLAS SUPPLY COMPANY, INC.,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

ALBERT M. PARKER,
Attorney for Respondents.
630 Fifth Avenue,
New York 20, New York.

HENNESSY & MOWRY,
FRANK H. HENNESSY,
Of Counsel,
55 North Dean Street,
Englewood, New Jersey.

Arthur W. Cross, Inc., Law Printers, 71-73 Clinton Street, Newark 5, N. J.—MArket 3-4994

TABLE OF CONTENTS.

	PAGE
OPINIONS BELOW	1
JURISDICTION	2
STATUTORY PROVISIONS	2
THE QUESTIONS PRESENTED FOR REVIEW	3
STATEMENT OF THE CASE	4
THE PETITION FOR CERTIORARI	7
ARGUMENT	12
THE QUESTION OF DISCRIMINATION	15
CONCLUSION	16

CASES CITED.

Grand Rapids Show Case Co. v. *Weber Show Case & Fixture Co.*, 38 F. (2d) 730, Cert. den. 281 U. S. 767, 74 L. Ed. 1174	6
Graver Tank Mfg. Co. v. *Linde Air Pdts. Co.*, 366 U. S. 271	13
Magnavox Co. v. *Hart & Reno*, 73 F. (2d) 433 C. C. A. 9 (1934)	6
Mahn v. *Harwood*, 112 U. S. 354	14
Miller v. *Brass Co.*, 104 U. S. 350	14
Moore v. *Hennessy, et al.*, 270 Fed. 2d 410, 123 U. S. P. Q. 1	1, 4
Sontag Chain Stores Co. v. *National Nut Co.*, 310 U. S. 281	14

Statutes Cited.

	PAGE
35 U. S. Code 266	10
28 U. S. Code 271	2, 9
28 U. S. Code 1400(b)	4
28 U. S. Code, Sec. 1254	2

Other Authority Cited.

Walker on Patents, Dellers Edition, Volume 3, Page 1681	5

IN THE

Supreme Court of the United States

No. 535—October Term 1961.

Roosevelt Moore,
Petitioner,

vs.

Jack P. Hennessy Co., Inc.,
Respondent.

Roosevelt Moore,
Petitioner,

vs.

Atlas Supply Company, Inc.,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

Opinions Below.

The opinion of the United States Court of Appeals for the Third Circuit on an initial venue question in *Moore* v. *Hennessy et al.*, is reported in 270 Fed. 2d 410, 123 U. S. P. Q. 1.

The opinion of the United States District Court for the District of New Jersey resulting from the consolidated trial on the merits of both actions is reported at 187 Fed. Supp. 868-871, 127 U. S. P. Q. 111.

The opinion of the United States Court of Appeals for the Third Circuit in the appeal from the decision of the United States District Court on the merits is reported at 293 Fed. 2d 44, 130 U. S. P. Q. 124.

Jurisdiction.

The jurisdiction of this Hon. Court appears to be invoked by Petitioner on the basis of 28 U. S. Code, Sec. 1254:

> "Courts of appeals; certiorari; * * *
> Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods;
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decrees;"

Statutory Provisions.

The statutory provisions on which Petitioner appears to have relied in these cases are 28 U. S. Code 271:

> "Infringement of patent.
>
> (a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention within the United States during the term of the patent therefor, infringes the patent.
>
> (b) Whoever actively induces infringement of a patent shall be liable as an infringer."

The Questions Presented for Review.

To the extent Respondents have been able to determine them from the Petition, the questions presented for review by Petitioner appear to be:

1. Whether the provision by another of a pin insertable in a hole for preventing the turning of a wheel can be held to be an infringement of Petitioner's U. S. Letters Patent #2,482,789 in view of the showing of a pin marked "5" in the said Letters Patent, but which pin is not even mentioned as an element in any of the claims of said Letters Patent.

2. Whether the provision by another of a "collar, sleeve, adapter or a wheel protector," referred to by petitioner at the middle of page 3 of the Petition as "No. 2 Part" but neither shown, described, nor claimed Petitioner's in said U. S. Letters Patent #2,482,789 can be held to be an infringement of said Letters Patent.

3. Whether apparatus for applying tires to wheels shown by the prior art to be in the public domain, said apparatus being devoid of Petitioner's alleged one inventive step, which step is included as an element in all of the claims of Petitioner's U. S. Letters Patent #2,482,789, could be held to be an infringement of said Letters Patent even if said Letters Patent were valid.

4. Whether said Letters Patent #2,482,789 is valid.

5. Whether Petitioner was discriminated against in the course of any of the proceedings below.

Statement of the Case.

In August 1958 Petitioner filed a Complaint in the District Court for the District of New Jersey against the United States of America, the Coats Company of Fort Dodge, Iowa, and several other manufacturers of tire applying apparatus having no place of business in New Jersey, alleging infringement of U. S. Letters Patent #2,482,789 owned by Petitioner and directed to "Circumferentially Travelling Type Tire Mounting Device". All of the defendants named in that Complaint moved to dismiss on the ground that the requirements for venue jurisdiction under 28 U. S. Code 1400 (b) had not been met. Before decision on that Motion as to the Coats Company, Petitioner amended his Complaint alleging the Jack P. Hennessy Co. Inc. of Englewood, N. J. to be general sales agent for the Coats Company. The complaint was dismissed as to all defendants, including the Jack P. Hennessy Co. Inc., with the suggestion by the District Judge, the Hon. Thomas F. Meaney, that Petitioner take the question of the dismissal with regard to the Coats Company and the Jack P. Hennessy Co. Inc. to the Circuit Court of Appeals. This Petitioner did and the Circuit Court of Appeals for the Third Circuit affirmed the dismissal as to the Coats Company but reversed as to the Jack P. Hennessy Co. Inc. (270 Fed. 2d 410), the only defendant not in the case originally.

Thereafter, Petitioner filed another Complaint against the Atlas Supply Co. Inc. of Newark, N. J. alleging infringement of his U. S. Letters Patent #2,482,789 by Atlas Supply Co. Inc. Inasmuch as the apparatus involved in both Complaints was the same, being tire mounting ap-

paratus manufactured by the Coats Company, of Fort Dodge, Iowa, the actions against the Jack P. Hennessy Co. Inc. and the Atlas Supply Co. Inc., were tried together.

On pre-trial, counsel for Respondent stated their intention to move for Summary Judgment, but were advised by Judge Meaney that in these cases there was to be a full and fair trial and that no such Motion would be entertained.

On the trial, the Hon. Judge Meaney first ascertained the facts on the question of whether the Jack P. Hennessy Co. Inc., as a sales representative for the Coats Company, and the Atlas Supply Co. Inc., a mere trademark licensing organization which does not make, use, or sell, anything but just allows its trademark to be applied to the goods tested by it, could be infringers of Letters Patent #2,482,789 and ruled from the bench that both of these companies were implicated in the question of sales, so "may be held to be engaged in selling within the purview of the act". (Transcript before the District Court, Page 37, lines 24-25). The trial on the question of validity and infringement then proceeded.

Petitioner was represented by counsel but inasmuch as his counsel was not particularly versed in patent law, the Hon. Thomas F. Meaney directed the course of the trial in a manner to make sure that Petitioner's case was put forth to the fullest extent that the merits of the case warranted. Illustrative of this was the permission granted to Petitioner to explain and introduce into evidence various pieces of apparatus brought into court by him, though as stated in Walker on Patents, Dellers Edition, Volume 3, Page 1681:

> "'It is axiomatic in the patent law that infringement depends, not upon what is manufactured or sold by the patentee, but upon what he has patented.' [*Magnavox Co.* v. *Hart & Reno*, 73 F. (2d) 433, 435, C. C. A. 9 (1934); see also *Grand Rapids Show Case Co.* v. *Weber Show Case & Fixture Co.*, 38 F. (2d) 730, 731, cert. den. 281 U. S. 767, 74 L. Ed. 1174.]"

From the File Wrapper of the U. S. Patent Application, Serial No. 641,858, from which Moore patent #2,482,789 matured (Exhibit D-1), it was shown that the claims in said patent were limited by the prior art and by estoppel to the precise apparatus defined in those claims, without any range of equivalence extending toward Respondent's apparatus. It was also seen from said File Wrapper that "Part No. 3" referred to by Petitioner in his petition, which is the part indicated at 5 in the drawing of Moore patent #2,482,789, was never included as even an element in claims submitted in said application, let alone being claimed per se. Furthermore, it is seen from that file wrapper (D-1), that Petitioner's "No. 2 Part, which is a collar, sleeve, adaptor, or a wheel protector, which slips over said fixed pivot No. 1 which wedges between the hub of the wheel and the counter post No. 1 for the purpose of locking the wheel" (Petition page 3), never existed in the said application Serial No. 641,858 so could not be present in Letters Patent #2,482,789 which matured from said application.

When the merits of the Action were established they clearly showed that the Coats Tire applying apparatus, to the sale of which Respondents had been held to contribute, did not infringe Petitioner's U. S. Letters Patent #2,482,-

789 and that the patent was invalid. Judge Meaney so properly held in his well considered opinion rendered September 30, 1960, 187 Fed. Suppl. 868-871, 127 U. S. P. Q. 111.

Petitioner took an appeal from the decision on the merits by the District Court to the United States Court of Appeals for the Third Circuit. Here, again, every consideration was shown Petitioner by the Court, including permission for him to again bring his apparatus into the Courtroom. From the questions asked Respondents' counsel from the bench, it was quite clear that the Court had looked into the case carefully. Specifically counsel for Respondents was asked whether the pin which Petitioner characterizes as his "Part No. 3" was shown anywhere in the prior art. Counsel for Respondents was able to point out, by reference to the File Wrapper of the Moore Application Serial No. 641,858 (D-1), that the publication from Aviation Magazine, Page 167, dated November 1944 and cited by the Examiner in the U. S. Patent Office in the Office Action of May 18, 1947 (D-1, Page 15), showed such pin. The United States Court of Appeals for the Third Circuit reached the same conclusion as that of Judge Meaney and accordingly affirmed the judgment of the United States District Court.

The Petition for Certiorari.

In his "Statement of Facts" Petitioner recites that "This patent arose out of Taspo, India, in October 1944". There has been no proof that whatever tools Petitioner may have devised in India are in any way comparable to the apparatus disclosed in his U. S. Letters Patent

#2,482,789. The earliest date, then, that Petitioner is entitled to is the January 17, 1946 filing date of his application Serial No. 651,858.

Petitioner's "No. 1 Part" which is the centerpost of the apparatus is recognized by Petitioner as being old. His "No. 2 Part" is neither shown nor described in his patent in suit, nor is there any language in the claims therein which would embrace such a part.

Petitioner's Part "No. 3", the pin 5 of his Letters Patent #2,482,789, was never made a part of any claim ever presented in his application, let alone being claimed per se. Furthermore, there is no language in any of the claims of the said Letters Patent which embraces such part.

Petitioner's parts, Nos. 4 and 5, the rollers which engage a tire to position it on a wheel, is apparatus within the public domain. The only additional feature supporting patentability for the claims of Moore patent #2,482,789 is an adjustable mounting of one of the rollers with respect to the arm carrying the other roller. There is no such adjustable mounting in Respondents' apparatus, thus Respondents' apparatus follows teachings which are in the public domain and on which Petitioner has no right to levy tribute. This finding was clearly set forth in the decision of the Hon. Thomas F. Meaney in the trial of the cases as reported in 187 Fed. Supp. 868-871.

Where Petitioner refers to the "Coats patent" he is understood to be referring to U. S. Letters Patent No. 2,505,172 to G. E. Coats dated April 25, 1950 for "Tire Changing Stand With a Rotatable Tool Supporting Shaft". Petitioner is apparently under the impression that if the

said Coats patent showed a construction responding to the terms of the claims in Petitioner's patent #2,482,789 this would somehow amount to infringement in accordance with the patent statutes. Counsel for Respondent sought diligently in the course of the proceedings below to explain to Petitioner that this was not so but that one would have to make, use, or sell, a patented invention to be an infringer in accordance with the statutes. (28 U. S. Code 271). Petitioner appears not to have been convinced. In any event, the apparatus shown in Coats patent #2,505,172 is not the same as the commercial form of the Coats Tire Applying Apparatus which Petitioner has alleged to be an infringement of his patent #2,482,789. Furthermore, even if the apparatus as shown in Coats Letters Patent #2,505,172 were made, used, and sold, it would not be an infringement of Petitioner's patent, for it does not respond to the claims of Petitioner's patent.

Considering the questions posed on Pages 6 and 7 of the Petition under the heading of "Referring to Part No. 2";

The answer to (a) is Yes.

The answer to (b) however is No, there is no such part shown or described anywhere in the Moore patent.

The answer to (c) is No, since the prior patents to Dickey and Weaver had other means for achieving the same end.

Under the heading "Referring to Part No. 3";

The answer to (a) is Yes.

The answer to (b) is also Yes, but there is no mention of this part in the claims of Moore's patent.

The answer to (c) is No, for these prior patents had other means for accomplishing this purpose.

Under the heading "Referring to Part No. 4 and 5":

The meaning of questions (a) (b) is a little obscure. If the meaning is that the third or second arm is what is mounted on the first arm and extends at approximately 90 with respect to the first arm, the answers to (a) and (b) are Yes. The answer to (c) is also clearly Yes, for the apparatus described in (a) and (b) is in the public domain as shown by the Dickey et al. patent #1,587,634 (Exhibit D-2) and the Weaver and Weaver et al. patents, numbered respectively #1,341,727 and #1,341,726 (Exhibits D-5 and D-4 respectively).

With respect to Petitioner's allegations on page 7 of the Petition "that the Government froze my patent and parts", U. S. Letters Patent could not have been issued at the "Separation Center". However, an examination of the File Wrapper of application Serial No. 641,858 of the application on which Petitioner's patent #2,482,783 issued shows that the prosecution of the application by patent attorneys of the Army Air Forces was carried out carefully and vigorously, resulting in the obtaining of claims of broad scope having regard to the merits of the invention and its position in the art. Furthermore, this prosecution was carried out without costs to Petitioner since the invention was held to come within the purview of the Act of March 3, 1883 as amended by the Act of April 30, 1928, 35 U. S. Code 266.

> "Issue of Patents Without Fees to Government Employees.
>
> The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or

> employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by and for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent."

The Final Judgment of the District Court is not correctly set out on page 10 of the Petition. The judgments in both the *Moore v. Jack P. Hennessy Co. Inc.* and *Moore v. Atlas Supply Company Inc.*, actions were identical. The text thereof as printed on page 10 of the Petition is correct only down through paragraph marked "2". The judgments as signed had no paragraph marked "4" or the substance thereof as set forth here. Instead, they terminated with the following paragraph marked "3":

> "3. Complaint herein is dismissed, without costs."

The words "without costs" were added by the Hon. Thomas F. Meaney in his own handwriting. The addition of these two words apparently resulted from Petitioner's intercession. Respondents had felt they were entitled to costs but had been satisfied to let the judgment end with the paragraph 3 reading "The complaint herein is dismissed."

Similarly, in affirming the decision of the District Court, the United States Court of Appeals for the Third Circuit initially (on July 10, 1961), issued a judgment affirming

that of the District Court "with costs". On August 8, 1961, however, the Court amended that judgment to make it conclude with the statement "each party to bear his own costs". Again, this change was apparently made as a result of Petitioner's intercession.

The Appendix to Brief of Defendants-Appellees filed in the United States Court of Appeals for the Third Circuit in the matter has an error at the top of page 1496. There it recites paragraph 3 of the Final Judgment in the case of *Moore* v. *Hennessy* as "The Complaint herein is dismissed". This quotation should have included the words "without costs" to correspond with the Judgment as filed in that case.

ARGUMENT.

No basis exists for this Honorable Court to exercise its discretion for the issuance of a Writ of Certiorari in this matter. There is no conflict between Circuits on the question of the validity and infringement of the patent in suit, there is no borderline question of patent law involved, and there are no other special or important reasons why a writ should issue in this instance. Furthermore, the Courts below made their decisions in keeping with prior decisions of this Honorable Court. They also followed the usual and accepted course in their handling of the controversy.

As regards the merits, the actions were simple ones for patent infringement which should never have been brought in the first instance. The lack of any infringement is clearly apparent when one attempts to read the claims of Petitioner's patent #2,482,789 on the apparatus manufactured by the Coats Company. It is fundamental in patent

law that it is the claims of a patent which measure the invention and define what the invention is. This Honorable Court has so held down through the years and reconfirmed that holding in the case of *Graver Tank Mfg. Co.* v. *Linde Air Pdts. Co.*, 366 U. S. 271, decided on February 28, 1949. There, Mr. Justice Jackson, in delivering the opinion of the Court, stated on Page 277 "We have frequently held it is the claims that measure the grant to the patentee". This yardstick was used by the Hon. Thomas F. Meaney in finding no infringement here and the United States Court of Appeals for the Third Circuit agreed with him wholeheartedly.

Respondent took considerably more than ordinary pains in briefing this matter below to bring that understanding home to Petitioner. In spite of the fact that the United States District Court for the District of New Jersey and the United States Court of Appeals for the Third Circuit accepted Respondents' view of the law, Petitioner is apparently sticking to the theory that there should be some other law applicable to his situation.

As striking examples of this are Petitioner's requests in paragraphs marked "A" and "B" on Pages 7 and 8 of the Petition, that this Honorable Court allow him to sue Respondents for $2,000,000.00 each for selling what he refers to as his "pin 5". The pin 5, however, was never even included as an element in any of the claims submitted in the course of the prosecution of application Serial No. 641,858 from which Patent #2,482,789 matured, let alone having per se been made the subject of a claim allowed by the Patent Office. The existence of such claims would be the minimum necessary as a basis for any such suits.

Respondents sincerely believe that the pin 5 as shown in Petitioner's patent was old in the art well before Petitioner filed his patent application. Even if it were not that old, however, it is shown without having been claimed in Petitioner's Patent #2,482,789. Thus, in accordance with another fundamental of the patent law, that disclosure was dedicated to and became freely available to the public on the issuance of the said patent. *Mahn* v. *Harwood*, 112 U. S. 354; *Miller* v. *Brass Co.*, 104 U. S. 350; *Sontag Chain Stores Co.* v. *National Nut Co.*, 310 U. S. 281.

With regard to the collar, sleeve or adaptor, claimed by Petitioner to have been copied from him, though he admits that it is hidden in his patent, Petitioner's contention is completely devoid of any substance. Even if one could find this element in the patent, it would still be dedicated to the public since there is no reference whatsoever to it in any of the claims.

With respect to Petitioner's request to sue the Government on the theory that the Government froze his patent, there has been no proof of any such thing. On the contrary, the Government's agents acted with due diligence in the prosecution of the application from which Petitioner's patent matured.

Concerning paragraph marked "D" on Page 8 of the Petition, it has previously been pointed out to Petitioner that protection on any novel mechanism should be sought through the United States Patent Office.

With respect to paragraph marked "E" it is believed that the original Letters Patent #2,482,789 forms plaintiff's Exhibit P-1 and is now in the custody of the Clerk of this Honorable Court.

The Question of Discrimination.

As pointed out in the foregoing, there is no basis whatsoever for Petitioner contending that he has been discriminated against in this matter. Certainly he has brought forward no facts to support any such charge. On the contrary, the charge is clearly negated by the consideration given Petitioner in the course of the proceedings below. In the first instance, the Hon. Judge Meaney, though of the belief that the amendment of the original Complaint to include the Jack P. Hennessy Co. Inc. was not proper, since the Court had no venue jurisdiction over any of the defendants named in the original Complaint, nevertheless suggested that the question be put right away to the United States Court of Appeals for the Third Circuit for its ruling. The Circuit Court affirmed as to the Coats Company, but reversed as to the Jack P. Hennessy Co. rendering it unnecessary for Petitioner to bring a new suit. Thereupon, the Hon. Thomas F. Meaney ruled out any summary proceedings for disposing of that suit as well as Petitioner's companion suit against the Atlas Company, and made sure that Petitioner got a full and fair trial. Then, though the merits of the matter were clearly in favor of Respondents, Judge Meaney, in signing the judgment, ruled out the possibility of costs to Respondents.

During the course of the trial below, Petitioner was given every opportunity to bring forward whatever he and his counsel thought would help his case.

Likewise, the United States Court of Appeals for the Third Circuit gave Petitioner every opportunity to press

his appeal and again freed him from the obligation of costs. Petitioner could not possibly bring forth any evidence to support the charge of Discrimination made on Page 9 of the Petition. The helpful treatment and consideration accorded him by the Courts paint a clear picture to the contrary.

Conclusion.

It is accordingly respectfully submitted that there is no basis for this Honorable Court exercising its discretion in the granting of the Writ of Certiorari requested by Petitioner and that the Petition should therefore be denied.

Respectfully submitted,

ALBERT M. PARKER,
Attorney for Respondents.

HENNESSY & MOWRY,
FRANK H. HENNESSY,
Of Counsel.